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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,509

11/19/2003

Masaki Wake

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7590

05/04/2007

BUCHANAN, INGERSOLL & ROONEY PC

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/715,509	Applicant(s) WAKE ET AL.	
	Examiner Ruth C. Rodriguez	Art Unit 3677	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-11 is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/19/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The indicated allowability of claim 13 is withdrawn in view of the newly discovered reference(s) to Japanese Patent Document JP 3001969 U cited in the Information Disclosure Statement filed by the Applicant on 19 April 2007. Rejections based on the newly cited reference(s) follow.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 19 April 2007 has been considered for this Office Action.

#### ***Claim Objections***

3. Claim 13 is objected to because of the following informalities: Claim 13, line 5, "bolts" should be replaced with --bores--. Correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Document JP 3001969 U.

An electric corrosion preventing apparatus (5) using a spacer (5) made of a metal and interposed between opposed faces of a steeling knuckle (3) and a caliper (2) both having respective bores co-axial with each other and fastened to each other by inserting a bolt (4) into the bores from the steeling knuckle side and tightening the bolt (Figs. 4 and 5). The spacer comprising a base interposed between the opposed faces of the bolts and having a through hole (5a) co-axial with the bores of the steeling knuckle and the caliper respectively so that the bolt is inserted through the hole. The base has a temporary retaining portion (5b) provided on an open edge of the hole of the base. The temporary retaining portion is inserted into the bore of the caliper and caught on a wall defining the bore (Figs. 4 and 5). The spacer having a surface to which an insulating coating is applied (Paragraph 0002).

***Allowable Subject Matter***

6. Claims 1-7 and 9-11 are allowed.
7. The following is an examiner's statement of reasons for allowance:

Soltysik discloses a spacer made of metal and interposed between opposed faces of two members having respective bores co-axial with each other and fastened to each other by inserting a fastening member into the bores and tightening the fastening

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member. The spacer comprises a base and a temporarily retaining portion. The base is interposed between opposed faces of the members and has a through hole co-axial with the bores of the respective members so that the fastening member is inserted through the hole. The retaining portion is provided on an open edge of the hole of the base to temporarily retain the overall spacer on one of the members before the members are fastened to each other. The temporarily retaining portion is inserted into the bore of the one member and caught on a wall defining the bore. Soltysik fails to disclose that the base is lying in a plane and the through hole being coplanar with the base with the temporary retaining portion extends directly from an open edge of the hole of the base in a direction substantially perpendicular to the plane. Accordingly, it would not have been obvious to one having ordinary skill in the art at the time the invention was made to have the through hole lying in a plane defined by the base and being coplanar with the base in such a way that the temporary retaining portion extends directly from an open edge of the hole of the base in a direction substantially perpendicular to the plane with a pair of projections being formed on respective opposite sides of a distal end of the retaining portion so that the projection extend in circumferential direction of the hole of the base.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Greenburg (US 1,400,155), Tinnerman (US 2,244,975), Johnson (US Re. 22,618 and Re. 22,544), Goldberg (US 3,226,145), McKewan (US 4,430,033), Bredal (US 4,749,318), Fisher (US 4,925,351), Ijima et al. (US 5,172,999), Bondarowicz et al. (US 6,582,171) and Hsich (US 6,811,347) are cited to show state of the art with respect to washers or spacers that have some of the features claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
April 30, 2007

A handwritten signature in black ink, appearing to read "K. Mitchell", written in a cursive style.

**Katherine Mitchell**  
**Primary Examiner**